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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,228	08/01/2001	Daniel J. Mendez	43630.00075	6520

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EXAMINER

HARRELL, ROBERT B

ART UNIT	PAPER NUMBER
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2142

DATE MAILED: 05/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/921,228

Applicant(s)

MENDEZ ET AL.

Examiner

Robert B. Harrell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20060208</u> . | 6) <input checked="" type="checkbox"/> Other: <u>see attached Office Action</u> . |

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1. Claims 35-40 remain presented for examination.
2. The applicant should always use this period for response to thoroughly and very closely proof read and review the whole of the application for correct correlation between reference numerals in the textual portion of the Specification and Drawings along with any minor spelling errors, general typographical errors, accuracy, assurance of proper use for Trademarks TM, and other legal symbols ®, where required, and clarity of meaning in the Specification, Drawings, and specifically the claims (i.e., provide proper antecedent basis for “the” and “said” within each claim). Minor typographical errors could render a Patent unenforceable and so the applicant is strongly encouraged to aid in this endeavor.
3. In light of the submitted prior art which lead to a series of follow up to date searching, the claims no longer stand allowable in view of the following rejection under 35 U.S.C. 102(e), and 35 U.S.C. 103, and grounds of rejection under 35 U.S.C. 102(e) and 35 U.S.C. 103 as indicated herein.
4. In light of page 8 (lines 8-11), Pre-Publication Number: 2002/0,035,618 (20020035618) paragraph [0021], the applicant has defined a “workspace element” to be: “each e-mail or e-mail folder, file or file folder, calendar or calendar folder, bookmark or bookmark folder, document or document folder, etc. may be referred to as ‘a workspace element.’”. Thus, for the whole of the prosecution history a “workspace element” has been defined as any generic file, folder, document, or other series of computer data, including a single binary bit or series of bits, per “etc” on line 10 of this application’s specification.
5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this action:

A person shall be entitled to a patent unless -

(e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language;
6. Claims 35-40 are rejected under 35 U.S.C. 102 (e) as being anticipated by Pruett et al. (United States Patent Number: 5,778,389).

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7. Prior to addressing the grounds of the rejections below, should this application ever be the subject of public review by third parties not so versed with the technology (i.e., access to IFW through Public PAIR (as found on <http://portal.uspto.gov/external/portal/pair>)), this Office action will usually refer an applicant's attention to relevant and helpful elements, figures, and/or text upon which the Office action relies to support the position taken. Thus, the following citations are neither all-inclusive nor all-exclusive in nature *as the whole of the reference is cited* and relied upon in this action as part of the substantial evidence of record. Also, no temporal order was claimed for the acts and/or functions.

8. Per claims 35-40, using claim 35 as a general guide with other claim limitations merged therein, Pruett taught a method and system, comprising:

- a) providing a first memory store (e.g., see figure 1 (30)) for storing workspace elements (e.g., see figure 1 (33 "FILES")) and note paragraph 4 above);
- b) providing a second memory store (e.g., see figure 1 (70)) coupled via an electronic network (e.g., see figure 1 (50) and link(s) between processor 12 and disk 20)) to the first memory store (e.g., see figure 1 (30)) for storing workspace element copies ((e.g., see figure 1 (33 "FILES"));
- c) receiving, via an interface (i.e., but not limited to the keyboard 15), new workspace elements, or changes, at the first memory store (e.g., see Abstract and figure 2a-2c));
- d) electronically transmitting, via use of the general synchronization module 41 routines of figure 1 used to move the FILES from the disk 20 to the server 10, as an example, copies of the new workspace elements, and changes, (e.g., see "FILES") via the electronic network ((e.g., see figure 1 (50) and link(s) between processor 12 and disk 20)) from the first memory store (e.g., see figure 1 (30)) to a global server (e.g., see figure 1 (10)); and,
- e) electronically transmitting, via synchronization agent 41 routines of figure 1 used to move the FILES from the global server 10 to the second memory and software in the client to aid in the synchronization function, copies and/or changes of the new workspace elements (e.g., see "FILES") via the electronic network (e.g., see figure 1 (50) and link(s) between processor 12 and disk 20)) from the global server (e.g., see figure 1 (10)) to the second memory store (e.g., see figure 1 (70), and Abstract).

9. Per claims 36-40, these claims do not teach or defined above the correspondingly rejected claims given above, and are thus rejected for the same reasons given above since the method claims mirror the system claims. However, as to "means-plus-function" claims, figure 1 provide the corresponding structures to those of this application in that the elements are general generic computer components over a LAN (i.e., the Internet contains LANs).

10. The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this office action:

- a) a patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject

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matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103, examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligations under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. 102 (f) or (g) prior art under 35 U.S.C. 103.

12. *Claim 35-40 are rejected under 35 U.S.C. 103(a)* as being unpatentable over Pruett et al. (United States Patent Number: 5,778,389).

13. Prior to addressing the grounds of the rejections below, should this application ever be the subject of public review by third parties not so versed with the technology (i.e., access to IFW through Public PAIR (as found on <http://portal.uspto.gov/external/portal/pair>)), this Office action will usually refer an applicant's attention to relevant and helpful elements, figures, and/or text upon which the Office action relies to support the position taken. Thus, the following citations are neither all-inclusive nor all-exclusive in nature as the whole of the reference is cited and relied upon in this action.

14. That which was anticipated was obvious.

15. While Pruett taught in col. 2 (lines 53-62) that the global server communicated with the first memory store, he did not clearly dictate the means for doing so. However, the essence of Pruett was not the communication link between the two and thus envisioned all known method to communicate including, but not limited to, local bus (SCSI), Network File Server (NFS), remote file server, RAID, and any other means to communicate between a server and its storage as such were known to be in the Prior Art as components to a computer storage device.

16. It would have been obvious to modify Pruett with a NFS since he was directed to a LAN and does not show the storage actually within the server but remote someplace on the LAN. The Internet is a World Wide LAN and/or incorporates LANs.

17. For the above, the claimed limitation of the global server in communication with the first memory storage via an electronic network has thus been addressed above.

18. For all of the above, it would have been either anticipated or obvious to synchronize email folders since Pruett recited "FILE" in the general manner which would have encompassed all known files including email, documents, program, exc... per col. 1 (lines 11-23). Specifically, per col. 1 (lines 11-23), that which was stored on a computer's storage device encompassed e-mail or e-mail folder, file or file folder, calendar or calendar folder, bookmark or bookmark

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folder, document or document folder, all of which were "types of information" called for by col. 1 (lines 11-23).

19. **A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the data of this letter. Failure to respond within the period for response will cause the application to become abandoned (see MPEP 710.02, 710.02(b)).**

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Harrell whose telephone number is (571) 272-3895. The examiner can normally be reached Monday thru Friday from 5:30 am to 2:00 pm and on weekends from 6:00 am to 12 noon Eastern Standard Time.

21. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew T. Caldwell, can be reached on (571) 272-3868. The fax phone number for all papers is (703) 872-9306.

22. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.



ROBERT B. HARRELL
PRIMARY EXAMINER
GROUP 2142